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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/845,280      | 04/30/2001  | Frank Thomas         |                     | 3073             |

7590 10/18/2002

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 10/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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OCT 18 2002  
GROUP 3700

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 10

Application Number: 09/845,280  
Filing Date: April 30, 2001  
Appellant(s): THOMAS, FRANK

CARELLA, BYRNE BAIN, GILFILLAN, CECCHI, STEWART & OLSTEIN  
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09/23/2002.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

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**(2) *Related Appeals and Interferences***

The brief contains a statement that there are no related appeals and/or interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The amendment after final rejection, filed May 06, 2002, has not been entered.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The appellant states that claims 1 and 4 stand or fall together in addition to stating that claim 2 stands alone and that claim 4 stands alone.

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

|           |        |         |
|-----------|--------|---------|
| 1,433,150 | REACH  | 10-1922 |
| 405329233 | SESAKU | 12-1993 |

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**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 STAND rejected under 35 USC §103(a) as being unpatentable over Reach in view of Seisaku et al (JP Patent No. 405329233). Reach shows the invention substantially as claimed and includes an alignment means extending along a portion of the top surface of the head and continuing along onto the hosel segment. The alignment means is in the form of a line that is generally parallel to a plane containing the striking face. Reach, however, does not show a line extending onto the shaft portion in either a continuous or discontinuous fashion. The Japanese reference to Seisaku shows it to be old in the art to include an alignment means in the form of a line-shaped piece of tape along the shaft in a direction that is parallel to the face of the putter. In both Reach and Seisaku, the intent is to provide a golfer standing at address with the ability to more readily align the striking face with a ball and the target. Taken as a whole, the references to Reach and Seisaku collectively teach that an alignment means such as a line may be placed along a path parallel to the plane of the striking face to help a player orient the club at address. It would appear that alignment is facilitated by a line on either a combination of the head and hosel segments of the head or on the shaft itself. Clearly, placing the alignment means on both the head and the

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shaft merely enhances the alignment effect. The fact that the claims require a continuous or discontinuous line would not appear to patentably distinguish over a combination of Reach and Seisaku, since either design for the line would appear to equally provide an appropriate visual alignment tool which a golfer may use to properly place the putter head with respect to a golf ball at address. In view of the patent to Seisaku and the above reasoning, it would have been obvious to modify the device in the cited reference to Reach by extending the line (c) along the shaft (b), the motivation being to simply enhance the effect of the alignment means. With respect to claim 4, note that Reach teaches that the line (c) may be cast as a groove or simply painted on the surface of the head and hosel.

**(11) Response to Argument**

In the arguments received 09/23/2002, the appellant contends that neither of the prior art documents to Reach nor Seisaku shows an alignment means extending along a surface of the shaft and the head in a plane perpendicular to the longitudinal axis and parallel to the striking face. The appellant notes that Figure 8 of Seisaku may appear to show a separate line on the head of the putter, but further argues that even if the separate line is viewed as a sight line, the separate line is not aligned with the tape (4) that is disposed along the shaft in Seisaku. The appellant contends that there is no motivation to combine the references such that the tape (4) taught by Seisaku should be placed on the shaft of the Reach device. Moreover, the appellant argues that there is no teaching in Reach or Seisaku to align the putter with a cup or intended path.

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In response to these arguments, it would appear that the appellant is attacking the references individually. One cannot show non-obviousness by attacking the prior art references on an individual basis where, as is the case in the rejection outlined above, the rejection is based on a combination of references. See In re Keller, 208 USPQ 871 (CCPA 1981). Moreover, it is recognized that the prior art references may not and cannot be combined in an arbitrary fashion and that there must exist some reason why the skilled artisan would have found it obvious to combine the primary and secondary teachings at the time of the invention. See In re Nomiya, 184 USPQ 607 (CCPA 1975). On the other hand, the patent statutes do not require that a motivation to make the proposed modification be expressly articulated in the references. The test for combining references is what the combination of the disclosures considered as a whole would have reasonably suggested to the ordinarily skilled artisan. See In re Simon, 174 USPQ 114 (CCPA 1972); In re McLaughlin, 170 USPQ 209 (CCPA 1971). Further, the combined references are to be evaluated by what they would have suggested to one of ordinary skill in the art, rather than by what is specifically disclosed by the references. See In re Bozek, 163 USPQ 545 (CCPA 1969). In this case, viewing the combined disclosures of both Reach and Seisaku would have clearly suggested to one of ordinary skill in the art that an alignment means might be fashioned to extend along a surface of both the shaft and the head. If in fact the appellant acknowledges that the Seisaku device displays a line on the putter head surface along with a tape on the surface of the shaft, such an observation would only appear to strengthen the position taken by the Office and set forth in the outstanding rejection of claims 1-4. That is, if one interprets

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Seisaku as including a line on the putter head along with a tape on the shaft, then the modification of Reach is most obvious, since Reach only lacks an alignment means on the shaft, said means being taught by Seisaku. Although the claims require that the alignment means extends along a surface of the shaft and the head, such a limitation does not distinguish over the combined teaching of Reach and Seisaku, which together clearly teach that alignment is facilitated by line-shaped markings on the head and the shaft.

As for the appellant's argument that neither Reach nor Seisaku teach aligning the putter with a cup or intended path, it would appear that the Reach and Seisaku devices are clearly designed to facilitate alignment of the putter with a cup or intended path. It simply would not make any sense whatsoever to design a putter wherein the structure of the putter does not permit a golfer to align a golf ball with a cup or intended path. If one takes the position of the appellant with respect to the lack in either Reach or Seisaku to specifically discuss the alignment of the putter, then one must conclude that these putters are substantially useless to a golfer. This is clearly not the case here, since both Reach and Seisaku are directed towards including alignment tools on the club to help a golfer align the putter.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Sebastiano Passaniti  
Primary Examiner  
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S.Passaniti/sp  
October 16, 2002

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